

Application No.: 10/008235

Case No.: 55393US011

**REMARKS**

Claims 1 to 64 are pending. Claims 1 to 7 and 28 to 63 are withdrawn from consideration. Claims 8 and 64 were previously presented and are now currently amended. Claim 26 was previously presented.

Claims 8 and 64 are amended to correct for erroneous placement of the descriptor "0.1 to 50 weight percent". In the original claims, the descriptor immediately preceeds "at least one of a heterocyclic radiation curable monomer", and in the currently amended claims 8 and 64, the same descriptor immediately preceeds "an adhesion promoting component". Support for this amendment in the original disclosure can be found on p. 3, line 30 to p. 4, line 4; and on p. 15, lines 4-6.

**§ 103 Rejections**

Claims 8 to 27 and 64 stand rejected under 35 USC § 103(a) as being unpatentable over WO 98/27171 in view of the state of the art as set forth in the instant specification in "Background of the Invention".

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

The Examiner claims that it would have been obvious to one skilled in the art at the time of the invention to combine the teachings of WO 98/27171 with the general knowledge that ink jet inks have a viscosity below 30 centipoise, and end up with the ink jettable fluid compositions of the instant invention. Agent respectfully submits that the Examiner is greatly oversimplifying the complexity of the instant invention, that there is no motivation to look to the art of screen printing, and that the combined references do not teach all of the claimed limitations.

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WO 98/27171 pertains to inks used for screen printing, and although they appear to be similar to the ink compositions of the instant invention, they are not. Screen printing is a technique in which an extremely viscous ink is poured onto a screen near one of its edges, and a knife is then used to spread the screen ink over the screen in some sort of uniform manner. The screen ink has rheological properties such that under no shear, it is very viscous (a glop), and under moderate shear, such as that provided by hand motion with a knife, the viscosity drops only slightly. The viscosity must then rebound quickly so that the screen ink does not drip off the screen.

The inks of WO 98/27171 contain a macromer and a rheology modifier referred to as Acryloid B-67. These components impart properties to the screen inks that one would not want to have for ink jet inks. Consider, for example, Example 7 of WO 98/27171 which the Examiner contends discloses the ink compositions of the instant invention. Reference is made to the concurrently submitted affidavit under CFR 1.132, in which the Applicant explains that he prepared Example 7 of WO 98/27171 and determined that the viscosity was around *3000 centipoise at room temperature and 500 centipoise at 55°C*.

Applicant submits that it is not reasonable, and it is perhaps naïve, to think that one could take a formulation for applying coatings, reduce its viscosity by 100-fold by changing amounts of components and removing other components, and end up with a formulation that can be properly jetted using an ink jet printhead. An ink jet printhead is a sophisticated device that is designed to push an ink through micrometer-sized nozzles in a precisely controlled manner. As described in the instant invention, ink jet inks have their own set of physical property requirements that are much more stringent than those for screen inks.

Claims 9-27 each add additional features to claim 8. Claim 8 is currently amended and is patentable for the reasons given above. Thus, claims 9-27 are likewise patentable.

In summary, the rejection of claims 8-27 and 64 under 35 USC § 103(a) as being unpatentable over WO 98/27171 has been overcome and should be withdrawn.

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**Double Patenting**

Claims 8-27 stand rejected under the judicially created doctrine of double patenting.  
Applicant respectfully defers response to this rejection given the amendments to the claims.

In view of the above, it is submitted that the application is in condition for allowance.  
Reconsideration of the application is requested.

Respectfully submitted,

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